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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,464	04/13/2004	Wayne Sicz	71043-002	4605

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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,464

Applicant(s)

SICZ ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005 and 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 and 21-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-11 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/4/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election of Species

Applicant's election with traverse of claims 1-24, 31 and 32 in the reply filed on April 4, 2005 is acknowledged. The traversal is on the ground(s) that claim 12 is generic as the "housing 130 is identified as being integral with the projection 82". This is not found persuasive because it is not the housing 130 that is at issue but whether the end cap is attached to the distal end of the projection or the housing 130. According to paragraph 041, the end cap 132 is secured to the housing and not the projection thus the end cap 132 is attached to the housing. Further, applicant cannot rely on the argument that the housing is the end cap when the housing and the end cap are two distinct features. The fact that the housing is integral with the projection has no bearing. The drawings do not show the endcap 132 attached to the projection but rather the housing 130. Applicant needs to keep a line of demarcation between the two species as the non-elected species shows the end cap 132' secured to the projection 82' (see paragraph 045 in line 5 as amended).

The requirement is still deemed proper and is therefore made FINAL.

Claims 12-19 and 21-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 4, 2005.

Drawings

The drawings were received on April 4, 2005. These drawings are not acceptable. Sheets 1 and 2 are being replaced; however, it is unclear what changes were made in the annotated sheets supplied or on the remarks to render sheets 1 and 2 replaced.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "28" has been used to designate both a locking mechanism with one configuration (Figs. 1-5) and a locking mechanism with another configuration (Figs. 8-10, 12, and 13).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "20" has been used to designate both a post assembly with one configuration (Figs. 1, 2, 4 and 5; having a magnetic locking mechanism) and a

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post assembly with another configuration (Fig. 9, 10, 12, 13; having another locking mechanism).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "88" has been used to designate both a plunger with one configuration (Figs. 2-5) and a plunger with another configurations (Figs. 12 and 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cienfuegos, 5,044,592, in view of Bowerman, 3,596,958.

Regarding claim 1, Cienfuegos discloses, in Figure 2, an adjustable bicycle seat post assembly comprising an outer seat tube **12**, an inner seat post **18**, a spring (unlabeled but shown near 12), and a latch member **28**. The tube **12** has an open upper end and an opposite lower end. The post **18** has a lower end telescopically received in the upper end and an opposite upper end. The spring is housed within the

tube **12** and acting with a constant spring force between the tube **12** and the post **18**. The latch member **28** is carried by the tube **12**. Applicant is reminded that the latch member **28** is able to engage with the post **18** when in a latched condition for selectively locking the post **18** in one of at least two positions of adjustment relative to the tube **12**. However, Cienfuegos fails to disclose a magnetic switch operative to move the latch member **28**. Bowerman teaches, in Figures 1 and 2, a magnetic switch **28, 38, 40** for moving a latch member **20,22** to lock two relatively slidable members in a selected position (col. 2, lines 58-61). Therefore, as taught by Bowerman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a magnetic switch to replace the locking mechanism comprised of the latch member.

Regarding claim 2, the switch magnet **28, 38, 40** includes a pair of switch magnets **38, 40** of opposite polarity.

Regarding claim 3, the magnetic switch **28, 38, 40** includes a switch housing supporting the switch magnets **38,40**.

Allowable Subject Matter

Claims 4-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 4, the prior art of record does not disclose or suggest an adjustable bicycle seat post assembly comprising a latch member moving under the influence of a changing magnetic field in response to moving switch magnets. Bowerman teaches a pair of switch magnets that do not move but instead uses a bar magnet to move the latch member; and,

regarding claims 5-11 and 20, these claims directly or indirectly depend from claim 4.

Response to Arguments

Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive.

Applicant has argued that Cienfuegos fails to provide any suggestion or motivation that the latch feature could or should be substituted by any other type of arrangement. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

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of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bowerman teaches the motivation, i.e., to move a latch to lock two relatively slidable members in a selected position (col. 2, lines 58-61), by using a magnetic switch. Furthermore, the knowledge available to one skilled in the art at the time the invention was made is to use a magnetic switch to move a latch. This teaching, itself, is a reason not to use a manual switch but rather use a magnetic switch.

Applicant further indicated that the device of Bowerman is an unusual device suggested for use on a smooth, flat, non-ferrous (e.g., wood) engagement surface so that its opposed locking magnet can align with corresponding sockets. In response, the examiner is aware of the differences of intended use for each device in the references; however, intended use has no weight when combining the references under the statute of 35 USC 103. Instead, when combining references, some teaching, motivation or suggestion has to exist in order to anticipate the claimed structural claims. Intended use is of no concern in determining patentability.

Applicant further argued that even if the references were combined there would be no reasonable expectation of success. In response, applicant should note that success is relative and not applicable to mechanical devices. One skilled in the art would recognize that using a magnetic latch device is more advanced than a manual latch device. Since the references, as combined, result a magnetic latch device,

inherently there will be an expectation of success as the modification results an operable device. Applicant has not indicated why the combined references will result the primary reference from not operating.

Applicant has argued that Cienfuegos '592 argues strenuously against any replacement of modification of its manual plunger-locking device. In response, where in the reference does Cienfuegos teach away from modification?

Applicant further argued that adjustable bicycle seat post assemblies are not one such application in Bowerman '958. In response, applicant has not indicated why are adjustable bicycle seat post assemblies not such an application.

Applicant has further argued that prior to applicant's invention, no one had thought to employ a magnetic switch to control a latch member in an adjustable seat post assembly. In response, applicant has failed to show, establish, or both, a long felt need. In other words, applicant has not proven that others have attempted and unable to solve a long felt need.

Applicant has further argued that there would be no reasonable expectation, if the manual plunger-latching device were substituted by Bowerman's. Applicant reasons that the Bowerman lock mechanism would be nearly impossible to operate while riding a bicycle, and that the latch of Bowerman is simply not capable operating within this

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type of environment. In response, why would it be nearly impossible? What structure prevents it from not operating and further what does the mode of operation have to do with patentability. It is clear from the drawings that a rider just has to raise from the seat while riding and the seat will adjust, due to the spring, once unlatched.

Applicant further argued that the latch in Bowerman could not realistically be rotated precisely 180 degrees under racing conditions to unlatch the seat post and then rotated again precisely 180 degrees to re-latch. In response, applicant has merely indicated an opinion that it is more difficult than applicant's invention to use, i.e., not "better".

Applicant further argued that Bowerman requires a planar surface against which the sliding mechanism of the latch operates and that no such planar surface exists in a typical seat post assembly. In response, there is no requirement that the posts in the claims be cylindrical when the telescoping members only need be complementary in shape, i.e., square, cylindrical, rectangular, or any other shape. In regards to the magnets being extremely soft and incapable of sustaining foreseeable shearing forces, one skilled in the art would obviously use magnetic materials that can sustain more shearing forces as in iron. Further, applicant has argued that Bowerman simply is not capable of operating within this type of environment. In response, applicant is reminded that no environment is specified in the claims and thus not required. Further, applicant

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should note that patentability is determined by the structure of the invention and not the intended environment where the invention is employed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

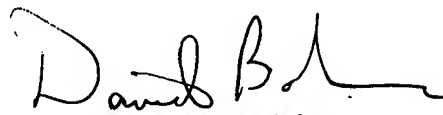
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

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August 1, 2005


DAVID E. BOCHNA
PRIMARY EXAMINER